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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/674,692

09/30/2003

Stephen H. Roby

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06/06/2007

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EXAMINER

ANTHONY, JOSEPH DAVID

ART UNIT

PAPER NUMBER

1714

MAIL DATE

DELIVERY MODE

06/06/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/674,692

Applicant(s)

ROBY ET AL.

Examiner

Joseph D. Anthony

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1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03/29/07 as RCE and Amendment.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 9-12 and 29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 9-12 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION AFTER FILING RCE**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5, 9-12 and 29 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Culpon, Jr. U.S. Patent Number 5,151,205.

Culpon, Jr. teaches a lubricating composition for chain and gear drive mechanisms. The composition comprises a polyalphaolefin base oil (none of which are disclosed to contain any phosphorous content at all), an ester oil solubilizer (such as trimethylol propane ester of C<sub>8</sub>-C<sub>10</sub> normal carboxylic acids or trimethylol propane ester of C<sub>7</sub>-C<sub>9</sub> normal carboxylic acids) that read directly on applicant's claimed polyol ester of the listed general formula in claim 1, and 2 to 4 wt % of a polybutene tackifier, see abstract, column 1, line 60 to column 2, lines 49 and TABLE 2. The preferred concentration range of the claimed trimethylol propane ester solublizer of C<sub>6</sub> to C<sub>12</sub> carboxylic acid is between 5 to 30 wt.%, see claims 1-2. The lubricating composition can contain optional additives such as extreme pressure and antiwear additives which may contain sulfur and phosphorus see Table 2 and claim 17. The composition replaces a mineral oil formulation and demonstrates persistent lubricity and substantially reduced smoking in chain and drive gear assemblies operated at high temperatures, see abstract.

Applicant's claims are deemed to be anticipated over the lubricating oil composition according to claims 1-2 when the concentration of the trimethylol propane

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ester solublizer of C<sub>6</sub> to C<sub>12</sub> carboxylic acid is at 5 wt.%. Please note that the synthetic base lubricating oil component in said lubricating oil composition, does not contain any phosphorous content at all and does not contain any sulfur content at all, see column 1, lines 60-65. As such, applicant's claimed limitation of independent claims 1 and 29 of: "wherein the composition has a phosphorous content not exceeding 0.08% by weight and a sulfur content not exceeding 0.2% by weight, based on the total weight of the composition" is inherently met. The addition of extreme pressure and antiwear additives which may contain sulfur and phosphorus are not required components, see independent claim 1, and are directly claimed to be only optional components, see dependent claim 17.

In the alternative, Culpon, Jr. could be said to differ from applicant's claimed invention in that there is not a direct teaching (i.e. by way of a specific example) to a lubricating oil composition that actually comprises applicant's component (b) ( i.e. polyol ester) within applicant's particular claimed concentration range of claims 1-5 and 9-12. It would have been obvious to one having ordinary skill in the art to make a lubrication oil composition that actually comprises applicant's component (b) within applicant's particular claimed concentration range since the patent directly disclosed and claims that a preferred concentration amount for the trimethylol propane ester solublizer of C<sub>6</sub> to C<sub>12</sub> carboxylic acid is 5 wt.%, see claim 2.

4. Claims 1-5, 9-12 and 29 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Field et al. WO 99/18175.

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Field et al. teaches a synthetic ester-containing lubricant with good soot-handling, see abstract. The ester additive is a polyol ester, preferably trimethylolpropane esterified by mixed C8 to C10 alkanolic acids. The concentration of the polyol ester additive is from 5 to 50 % by weight of the total lubricant composition, see page 5. The synthetic ester-containing lubricant may further comprise known additives such as: viscosity modifiers, corrosion inhibitors, oxidation inhibitors, dispersants, anti-foaming agents, pour point depressants etc., see page 16. Applicant's claims are deemed to be anticipated over said disclosure of the reference. Please note that it is notoriously well known in the art that synthetic lubricants, minus optional additives, are made free of phosphorous and sulfur. As such, the synthetic lubricant used in the examples of the reference does not contain any phosphorous or sulfur.

In the alternative, Field et al. could be said to differ from applicant's claimed invention in that there is not a direct teaching (i.e. by way of a specific example) to a synthetic lubricating oil composition that actually comprises applicant's component (b) (i.e. polyol ester) within applicant's particular claimed concentration range of claims 1-5 and 9-12. It would have been obvious to one having ordinary skill in the art to make a lubrication oil composition that actually comprises applicant's component (b) within applicant's particular claimed concentration range since the reference directly discloses that the concentration amount for the trimethylol propane ester solublizer of C<sub>8</sub> to C<sub>10</sub> carboxylic acid is 5 to 50wt.%, see page 5.

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5. Claim 29 is rejected under 35 U.S.C. 102(b) as being anticipated by Dillworth et al. U.S. Patent Number 5,958,089.

Dillworth et al. teach an additive composition comprising: (a) an ashless dispersant comprising an acylated nitrogen compound; and (b) a carboxylic acid, or an ester of the carboxylic acid and an alcohol wherein the acid has from 2 to 50 carbon atoms and the alcohol has one or more carbon atoms (reads on applicant's polyol esters), which provides an improvement in the lubricity of fuel oils and exhibits improved solubility in the fuel oil, see abstract. The sulfur content of the fuel oil is 0.05% by weight or less, see column 3, lines 38-41. The concentration of the polyol ester additive is from 10 to 5,000 ppm (i.e. 0.001 to 0.5% by weight) of the fuel oil, see column 8, lines 61-67. Applicant's claim is deemed to be directly anticipated over the examples which use a fuel oil free of phosphorous, and has no phosphorous containing additives added thereto.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-5, 9-12 and 29 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-46 of copending Application No. 11/046,994. Although the conflicting claims are not identical, they are not patentably distinct from each other because the pending claims are a subset of the pending claims in S.N. 11/046,994.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Response to Arguments***

8. Applicant's arguments filed 3/29/07 with the Amendment and RCE have been fully considered but are not persuasive to put the application in condition for allowance for the reasons set forth above. Additional examiner comments are set forth next.

Applicant's main argument against the applied Culpon, Jr. patent is that: *"At the time of filing the Culpon application, i.e., May 13, 1991, governing regulatory agencies did not have the low phosphorous and low sulfur requirements that exist in the industry today. Thus even by employing a synthetic oil inherently free of sulfur, phosphorous and metals, Culpon would not have possibly contemplated claiming a lubricating oil*



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*composition having any limits to the phosphorous and sulfur content therein and would have used additives containing high amounts of phosphorous and sulfur. As such, the lubricating oil compositions of Culpon would not possibly place the claimed lubricating oil composition of Claim 1 in the possession of the public.”*, see pages 7-8 of the amendment. The Examiner must totally disagree with applicant's position.

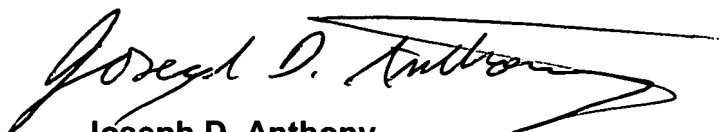
The FACT of the matter is that Culpon, Jr. claimed lubricating oil compositions meet applicant's claimed phosphorous and sulfur limitations because Culpon's claimed compositions of claims 1-2 do not contain any phosphorous and sulfur. Even if applicant is correct that Culpon would not have contemplated having any limits on the phosphorous and sulfur content due to governmental regulations and environmental issues, such is totally moot, since Culpon's taught and claimed lubrication oil compositions are free of phosphorous and sulfur, and meet all of applicant's other claimed limitations. As such, phosphorous and sulfur free lubrication oils, containing applicant's claimed polyol esters, have long been in possession of the public since such are taught by Culpon. Furthermore, the examiner rejects applicant's contention that Culpon would have no motivation to make *lubricating oil compositions having any limits to the phosphorous and sulfur content therein*. Applicant's attention is drawn to Culpon's column 1, lines 63-65 wherein it is stated: “*These synthetic base oils are inherently free of sulfur, phosphorous and metals **and produce less obnoxious smoke***.” To make lubricant compositions that produce less obnoxious smoke was a recognized benefit at the time of filing of Culpon's invention!

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Finally, applicant's arguments in regards to independent claim 29 are not well taken since Culpon's required tackifier component clearly reads on applicant's claimed additives, such as friction modifiers, and viscosity index improver. Many other of applicant's claimed additives would also seem to read on Culpon's tackifier component since such a tackifier would seem to inherently function as a corrosion-inhibitor, an anti-icing agent, a pour point depressant etc., even if such functions are not directly taught by the reference.

***Examiner Information***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (571) 272-1117. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (571) 272-1119. The centralized FAX machine number is (571) 273-8300. All other papers received by FAX will be treated as Official communications and cannot be immediately handled by the Examiner.



**Joseph D. Anthony**  
**Primary Patent Examiner**  
Art Unit 1714

6/1/07